

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 62

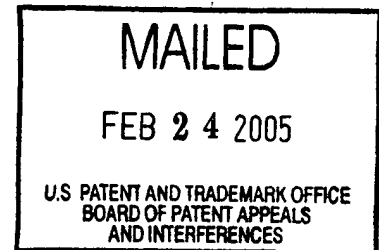
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HISASHI YAMAGISHI,
HIROSHI HIGUCHI, YASUSHI ICHIKAWA
and JUNII HAYASHI

Appeal No. 2004-1203
Application No. 08/898,853

HEARD: February 9, 2005



Before FRANKFORT, MCQUADE, and NASE, Administrative Patent Judges.

MCQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Hisashi Yamagishi et al. appeal from the final rejection (Paper No. 39) of claims 13 through 19, all of the claims pending in the application.¹

THE INVENTION

The invention relates to "a multi-piece solid golf ball having a structure of at least four layers" (specification, page 1). Representative claim 13 reads as follows:

13. A solid golf ball comprising a solid core having a three-layered structure composed of an inner layer, an intermediate layer formed outside said inner layer, and an outer layer formed

¹ The appellants canceled allowed claims 1 through 12 subsequent to final rejection.

outside said intermediate layer, and a cover for coating said solid core, wherein:
said inner layer is designed to have a Shore D hardness which is lower than that of said intermediate layer;
said intermediate layer is designed to have a Shore D hardness of 45 to 65; and
said outer layer is designed to have a Shore D hardness which is lower than that of said intermediate layer.

THE REJECTION

Claims 13 through 19 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

Attention is directed to the main and reply briefs (Paper Nos. 48 and 50) and the final rejection and answer (Paper Nos. 39 and 49) for the respective positions of the appellants and the examiner regarding the merits of this rejection.

DISCUSSION

The examiner's explanation of the rejection indicates that it is predicated on an alleged failure of the specification to comply with the written description requirement of 35 U.S.C. § 112, first paragraph. The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventors had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language. In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983).

The record indicates that the appellants originally copied claims 13 through 19 from U.S. Patent No. 5,743,816 to Ohsumi et al. in order to provoke an interference.² As indicated above, independent claim 13 recites a solid golf ball comprising a solid core and a cover, with the core having a three-layered structure composed of an inner layer, an intermediate layer and an outer layer. In contrast, the original disclosure in the instant application describes “a multi-piece solid golf ball having a structure of at least four layers, comprising a core having a structure consisting of at least two layers and a cover enclosing the core and consisting of inner and outer cover layers” (specification, page 2). The examiner contends that such disclosure runs afoul of the written description requirement with respect to the subject matter recited in claims 13 through 19 because

[t]he specification does not substantially disclose a third layer on the core of the golf ball. There is an option of providing additional layers (spec 9 line 5) but there are no specific details given regarding the characteristics. Particularly there is no mention of the Shore D hardness being less than the second layer (claim 13) or the thickness (claim 15). Furthermore, there is no mention of the specific gravities in claim 16 or the materials in claim 18 [final rejection, page 2].

The appellants counter that the rejection is unsound because the limitations in the appealed claims relating to the outer “core” layer find written descriptive support in their original disclosure of the inner “cover” layer. According to the appellants, “[i]t is merely a matter of nomenclature as to whether one considers the third layer as part of the core or the cover” (main brief, page 8). To support this position, the appellants have appended a number of evidentiary

² Claims 14, 15 and 18 have since been canceled.

items to the main brief, the most relevant of which is the uncontested 37 CFR § 1.132

Declaration of Larry C. Cadorniga which discusses the lack of any definitive standard in the industry for designating intermediate layers of a solid golf ball as either core or cover layers.

In the main brief, the appellants point out how, if the disclosure of the inner cover layer provides the requisite written descriptive support for the recitation in the claims of the outer core layer, the golf ball originally disclosed in the instant application would embody the Shore D hardness characteristics recited in claim 13, the thicknesses (or diameters) recited in claim 15, the specific gravity relationships recited in claim 16 and the particular materials recited in claim 18. The appellants' analysis here is reasonable on its face and has not been disputed by the examiner. Thus, the dispositive issue in the appeal is whether the appellants' original disclosure of the inner cover layer provides written descriptive support for the outer core layer recited in the claims.

Given the fair teachings of the original disclosure, the scope of the appealed claims and the evidence before us, it matters not in this particular case whether the golf ball layer in question is designated as an inner cover layer as in the appellants' original disclosure or an outer core layer as in the appealed claims. On the record before us, and notwithstanding the noted differences in terminology or nomenclature, one of ordinary skill in the art would have readily appreciated the outer core layer recited in the appealed claims to be encompassed by the description of the inner cover layer in the appellants' original disclosure, and in a more general sense the solid golf ball recited in the appealed claims to be encompassed by the description of the

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solid golf ball in the appellants' original disclosure.³ Thus, the disclosure of the application as originally filed would reasonably convey to the artisan that the appellants had possession at that time of the subject matter now recited in claims 13 through 19.⁴

Accordingly, we shall not sustain the standing 35 U.S.C. § 112, first paragraph, rejection of claims 13 through 19.

SUMMARY

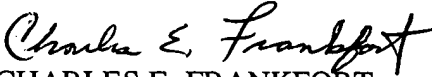
The decision of the examiner to reject claims 13 through 19 is reversed.

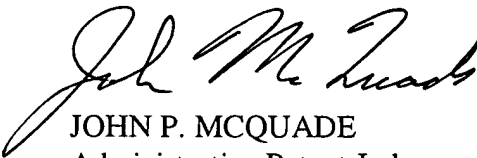
³ The appellants should note, however, that 37 CFR § 1.75(d)(1) requires that "[t]he claim or claims must conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description."

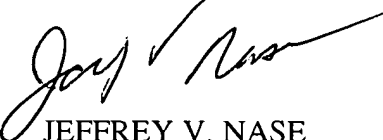
⁴ One of the arguments advanced by the examiner involves the citation of Gentry Gallery, Inc. v. Berkline Corp., 134 F.3d 1473, 45 USPQ2d 1498 (Fed. Cir. 1998) for the proposition that the doctrine of file wrapper estoppel precludes the appellants' position in this appeal due to arguments made earlier in the prosecution of this application. Suffice to say that neither Gentry nor any other authority of which we are aware supports this argument.

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REVERSED


CHARLES E. FRANKFORT
Administrative Patent Judge


JOHN P. MCQUADE
Administrative Patent Judge


JEFFREY V. NASE
Administrative Patent Judge

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